

## **REMARKS/ARGUMENTS**

### **I. General Remarks**

Claims 21-29, 31 and 36-43 were pending in the last office action. Applicants previously cancelled claims 1-20 in response to a restriction requirement. Claim 21 has been amended herein. Claims 22-28, 30, 32-36, and 38-43 have been cancelled. Applicants respectfully request that the above amendments be entered, and further request reconsideration in light of the amendments and remarks contained herein.

Applicants respectfully submit that these amendments add no new matter to the application and are supported by the specification as originally-filed. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants thank the Examiner for his careful consideration of this application.

### **II. Remarks Regarding Attorney Docket Number**

Applicants inadvertently included the incorrect Attorney Docket Number (HES 2002-IP-006415U1P1D1) in their original response and have changed the Attorney Docket Number in the heading above to reflect the correct docket number, which is HES 2002-IP-006415U1P1D2.

### **III. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 102(e)**

The Examiner has rejected claims 21, 23, 24, 26, 29 31, and 36-38 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0043906 issued to Heath *et al.* (hereinafter "*Heath*") (Office Action at 3.) With respect to this rejection, the Examiner has stated:

Heath teaches a pelletized material which comprises metal salts and tracers, such as barite and particulate material such as sand (see 0018, 0019 and 0028). The pelletized materials contain polymers, which are a resin composition as claimed. Heath (see 0026 and 0027) further teaches metals salts may be incorporated into a plastics matrix, absorbed and/or encapsulated. Applicant's intended use as a proppant with tracking material does not distinguish (In re Pearson 181 USPQ 641).

(Office Action at page 3.) Applicants respectfully disagree.

With respect to as-amended independent claim 21, *Heath* does not disclose each and every element as set forth in the claim because *Heath* does not disclose "a particulate material wherein the particulate material has been coated with a coating composition comprising a tracking composition and a resin composition, wherein the tracking composition comprises a

substantially non-radioactive tracking material selected from the group consisting of: a metal salt wherein the metal portion is selected from the group consisting of gold, silver, copper, aluminum, cobalt, iron, lithium, magnesium, molybdenum, nickel, phosphorus, lead, titanium, and vanadium; and a metal salt selected from the group consisting of barium bromide, barium iodide, beryllium fluoride, beryllium bromide, beryllium chloride, cadmium bromide, cadmium chloride, cadmium iodide, cadmium nitrate, chromium bromide, chromium chloride, chromium iodide, cesium bromide, cesium chloride, sodium bromide, sodium iodide, sodium nitrate, sodium nitrite, potassium iodide, potassium nitrate, manganese bromide, manganese chloride, zinc bromide, zinc chloride, zinc iodide, sodium monofluoroacetate, sodium trifluoroacetate, sodium 3-fluoropropionate, potassium monofluoroacetate, potassium trifluoroacetate, and potassium 3-fluoropropionate.” Rather, *Heath* discloses “a spherical, plastic chemical release capsule” that may contain a tracer inside the capsule. (*Heath*, Abstract; para [0028]). As such, *Heath* does not disclose each and every element of Applicants’ claims.

Consequently, for at least all the reasons stated above, Applicants respectfully submit that these claims are patentable over *Heath*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 29, 31 and 37 depend from claim 21, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

#### **IV. Remarks Regarding Rejections Under 35 U.S.C. § 102(b)**

Claims 21, 29 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,209,643 issued to Nguyen, *et al.* (hereinafter “*Nguyen*”). With respect to this rejection, the Examiner writes that:

US ‘643 teaches a proppant within the scope of the present invention (column 4, line 16 et seq), which comprises resin-material mixture (see examples and claims). The material used may be a salt, such as sodium persulfate (Example III). Applicant’s intended use as a tracking material does not distinguish (In re Pearson 181 USPQ 641).

(Office Action at page 3.)

In order to form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2006). With respect to as-amended independent claim 21, *Nguyen* does not disclose

each and every element as set forth in the claim because *Nguyen* does not disclose “a particulate material wherein the particulate material has been coated with a coating composition comprising a tracking composition and a resin composition, wherein the tracking composition comprises a substantially non-radioactive tracking material selected from the group consisting of: a metal salt wherein the metal portion is selected from the group consisting of gold, silver, copper, aluminum, cobalt, iron, lithium, magnesium, molybdenum, nickel, phosphorus, lead, titanium, and vanadium; and a metal salt selected from the group consisting of barium bromide, barium iodide, beryllium fluoride, beryllium bromide, beryllium chloride, cadmium bromide, cadmium chloride, cadmium iodide, cadmium nitrate, chromium bromide, chromium chloride, chromium iodide, cesium bromide, cesium chloride, sodium bromide, sodium iodide, sodium nitrate, sodium nitrite, potassium iodide, potassium nitrate, manganese bromide, manganese chloride, zinc bromide, zinc chloride, zinc iodide, sodium monofluoroacetate, sodium trifluoroacetate, sodium 3-fluoropropionate, potassium monofluoroacetate, potassium trifluoroacetate, and potassium 3-fluoropropionate.” Rather, *Nguyen* discloses a method of treating a subterranean formation using a treatment fluid that comprises proppant particulates that have been coated with a treatment chemical such as a breaker, scale inhibitors, biocides, corrosion inhibitors, paraffin inhibitors, etc. (*Nguyen*, col. 3, lines 37-57; col. 4, lines 40-46). As such, *Nguyen* does not disclose each and every element of Applicants’ claims.

Consequently, for at least all the reasons stated above, Applicants respectfully submit that these claims are patentable over *Nguyen*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 29, 31 and 37 depend from claim 21, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

#### **V. No Waiver**

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s

additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

**SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with this filing. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.1133.

Respectfully submitted,



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Larissa A. Piccardo  
Registration No. 60,448  
BAKER BOTTS L.L.P.  
One Shell Plaza  
910 Louisiana  
Houston, TX 77002  
Telephone: 713.229.1465  
Facsimile: 713.229.7765  
Email: larissa.piccardo@bakerbotts.com

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